

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Timans, et al.

Application No.: 10/777,790

Filed: February 8, 2001

For: MAMMALIAN CYTOKINES;  
RELATED REAGENTS

Examiner: D. JIANG

Art Unit: 1646

Conf. No.: 3044

Mail Stop: Petitions  
Commissioner for Patents  
PO Box 1450  
Alexandria VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR  
RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF  
ALLOWANCE (37 C.F.R. § 1.705)(b)**

Sir:

The patent term adjustment for this case indicated by the Office Action mailed November 24, 2008, is 516 days. It appears that the PTO, in calculating the total numbers of days of PTO delay, may not have considered the period of 255 days in excess of three years of issuing the patent in addition to the period of 540 days in excess of 14 months to mail the first PTO action. A detailed review of the file history of this application leads Applicant to believe that the patent term adjustment should be 771 days and not 516 days. The basis for this correction is indicated below.

37 CFR §1.702(a)(1) and §1.703(a)(1) indicates that the PTO must mail the first office action within 14 months of the filing date of the subject application. In the present case, a restriction requirement was the first office action and it was mailed October 3, 2006, which is 540 days after the 14 month due date, which would have fallen on April 11, 2005.

In addition, 37 CFR §1.702(b) and 1.703(b) indicate that the PTO must issue a patent 3 years after the filing date of the subject application. The issue fee is due February 24, 2009 and the estimated issue date is June 2, 2009, or 255 days after the 3 year due date, which would have fallen on February 11, 2007.

We understand that on September 30, 2008 in *Wyeth et al. v. Dudas*, No. 07-1492, the District of Columbia District Court overturned the USPTO's interpretation of 35 USC 154(b)(2)(A), which we understand to have been that the "Actual Delay" limitation, where to the extent that periods of delay overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed. Here, we believe that the PTO interpreted the delay of the first office action to overlap the number of days the issuance of the patent was delayed, thus only the delay based on the delayed issuance of the first action was considered in the patent term adjustment. However, under *Wyeth* the total number of days should include the 255 day Issue of patent delay as well as the 540 day first office action delay (minus 24 days of Applicant delay), which results in a total patent term adjustment of 771 days.

In view of the foregoing, it is respectfully requested that this request for reconsideration of the patent term adjustment be considered and that the PTO send out a revised notice of Determination of Patent Term Adjustment and that the correct patent term adjustment be noted on the face of the patent.

Applicants further note that this Application for Patent Term Adjustment is being submitted prior to payment of the Issue Fee.

The fee of \$200.00 set forth in (37 C.F.R. § 1.18(e), required by (37 C.F.R. § 1.705 (b) (1)), and any additional fees, may be charged to DNAX Deposit Account No. 04-1239. Any refund in fees may be credited to the same Deposit Account.

If the Examiner has any questions, the Examiner is invited to contact the undersigned.

Respectfully submitted,

Date: 30 January 2009

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